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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/642,388	08/18/2000	Edward J. Bawolek	042390.P5751C	1183

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EXAMINER
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WU, JINGGE

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 05/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/642,388	BAWOLEK ET AL.	
	Examiner	Art Unit	
	Jingge Wu	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2005.  
2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 22-43 is/are pending in the application.  
4a) Of the above claim(s) 37-43 is/are withdrawn from consideration.  
5) ☐ Claim(s) 28-36 is/are allowed.  
6) ☐ Claim(s) 1-27 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicants' response to the last Office Action, filed on March 7<sup>th</sup>, 2005 has been entered and made of record.

Applicants' amendment has required new grounds of rejection. New grounds rejection are therefore presented in the Office Action.

### **Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 22 –27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-5 of U.S. Patent No.

6205244. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim 1 of US 6205244 is a similar claim form of the independent claim of the application. Even though the claim language is not identical, the subject of the claims are well known in the art. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use

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the scheme of second set of response in the method of Bawolek et al in order to obtain an accurate color calibration matrix.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5982957 to DeCaro et al. (a reference of record) in view of US 6351308 to Mestha.

As to claim 22, DeCaro discloses A method to calibrate imager device responses, comprising:

- presenting a plurality of light radiating sources (fig. 17-19, 202-218);

- producing a first set of responses based the plurality of light radiating sources (col. 11 lines 10-45, note that this can be the first sub-set of response using sensor 140);

- producing a second set of responses form a imager device (scanner) by exposing an imager device to the plurality of light radiating sources (col. 11 lines 10-45, note that this can be subsequent subset response); and

- determining calibrating coefficients from the first set of responses and the second set of responses (col. 11, lines 44-45, col. 7 lines 1-64).

Decaro did not explicitly mention using a spectrophotometer to create the responses that is well known in the art.

Mestha, in an analogous environment, teaches using a spectrophotometer (12)exposed in a plurality of LEDs (10, fig. 5) to get the response for calibration coefficients (fig. 5, col. 12 line 37-col. 13 line 25)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the spectrophotometer exposed to the plurality of light radiating sources of Mestha in the system of Decaro in order to get accurate reference color response.

As to claim 23, DeCaro further discloses the method of claim 22, wherein presenting a plurality of light radiating sources includes presenting three to more than five light emitting diodes (202-218), wherein each light emitting diode includes a

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different spectral radiation characteristic within the spectral sensitivity of the human visual system (figs. 17-19).

As to claim 25, DeCaro further discloses the method of claim 22 wherein producing the first set of responses includes mapping the first set of responses as red, green, and blue values into a plurality of XYZ tristimulus values (col. 9 lines 14-41).

As to claim 27, DeCaro further discloses the method of claim 22 wherein exposing the imager device to the plurality of light radiating sources includes illuminating the imager device sequentially with each of the light radiating sources (fig. 20, col. lines 10-45).

As to claim 24, DeCaro further discloses presenting three to more than five light emitting diodes includes presenting five light emitting diodes having the peak wavelengths of 660nm, 592nm, 550nm, 474nm, and 456nm but does not explicitly mention 590nm, 545nm, 470nm, and 430nm.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the LEDs of peak wavelengths of 592nm, 550nm, 474nm, and 456nm instead of 590nm, 545nm, 470nm, and 430nm. Applicant has not disclosed that using LEDs of peak wavelengths of 590nm, 545nm, 470nm, and 430nm that provides a particular advantage, or for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the LEDs disclosed in DeCaro because there are very minor difference of the peak wavelengths.

Therefore, it would have been obvious to combine to one of ordinary skill in this art to modify LEDs with to obtain the invention as specified in claim 24.

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As to claim 26, Mestha further discloses producing the first set of responses based on the plurality of light radiating sources that includes exposing a spectrophotometer to the plurality of light radiating sources (fig. 3 and 5).

***Allowable Subject Matter***

Claim 28 is allowed. Claims 29-36 depend from claim 28 are, therefore, allowed.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

**Contact Information**

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Any inquiry concerning this communication or earlier communications should be directed to Jingge Wu whose telephone number is (571) 272-7429. He can normally be reached Monday through Thursday from 8:00 am to 4:30 pm. The examiner can be also reached on second alternate Fridays.

Any inquiry of a general nature or relating to the status of this application should be directed to TC customer service whose telephone number is (571) 272-2600.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Amelia Au, can be reached at (571) 272-7414.

The Working Group Fax number is (703) 872-9306.

Jingge Wu

Primary Patent Examiner

